

REMARKS

I. Objection

The Examiner has objected to the specification for an unnecessary amendment. Applicants have amended the objected paragraph based on the Examiner's suggestion and it is respectfully submitted that this objection has been overcome.

II. Claims Rejection under Section 103

Claims 57-61

The Examiner has rejected claims 57-61 under 35 U.S.C. § 103(a) as being unpatentable over Franchi (U.S. Patent No. 5,770,533) in view of Gimmon (U.S. Patent No. 5,096,195). Applicants respectfully assert that claims 57-61 are not obvious over Franchi in view of Gimmon because there is no suggestion or motivation to combine Franchi with Gimmon to provide a gaming device capable of receiving data via a first two-way communication channel from a computer while the gaming device is housed within a dispenser, such first two-way communication channel being secure.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432." MPEP 2143.01. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP 2143.03.

The objective in Franchi is to minimize cheating and improve surveillance of casino games by providing an encoded betting card to a casino player, such betting card containing the player's identification, cash balance and other applicable information (Abstract, col. 2, lines 42-54, col. 6, line 65 – col. 7, line 15). In order for a RSAT holder to release a RSAT 1600 to a player, the player must first insert a betting card 401 into the RSAT holder (col. 15, lines 38-41 and figure 16). When the player inserts the betting card 401 into the RSAT holder, "the RSAT 1600 downloads player information including credit

balance information from the betting card 401 into the random access memory." (col. 15, lines 41-44). Accordingly, there is no suggestion or motivation (or need) in Franchi to provide data to the RSAT 1600 from the RSAT holder or from a computer system while the RSAT 1600 is housed within the RSAT holder. In fact, as disclosed in Franchi, no such data is available for the RSAT holder or the computer system to provide to the RSAT 1600. Contrarily, all data that is downloaded or provided to the RSAT 1600 is contained within or comes from the player's betting card. Further, if such data is provided from the RSAT holder or the computer system to the RSAT 1600 while the RSAT 1600 is housed within the RSAT holder, there is no longer a need to provide betting cards to players rendering the Franchi invention unsatisfactory for its intended purpose. Moreover, eliminating the betting cards changes the principle of operation and objectives in Franchi, which is to provide betting cards having improved security to casino players. Thus, the mere fact that Franchi can be combined with Gimmon to provide a RSAT capable of receiving data via a secured first two-way communication channel from a computer while the RSAT is housed within the RSAT holder does not render the present disclosure obvious because Franchi does not suggest a desirability for such combination. In re Mills. Indeed, Franchi teaches away from such a concept by disclosing and claiming the player's betting card. (See, claims 47-49).

Since independent claim 57 is not obvious under Section 103, then any claims depending therefrom are nonobvious, namely claims 58-61. In re Fine. Thus, claims 57-61 are patentably distinct as written and the rejection of these claims under Section 103 should accordingly be withdrawn.

Claims 62-64

The Examiner has rejected claims 62-64 under 35 U.S.C. § 103(a) as being unpatentable over Franchi and Gimmon in view of Walker (U.S. Patent No. 6,024,640). As discussed above, there is no suggestion or motivation to combine Franchi with Gimmon to provide a gaming device capable of receiving data via a secured first two-way communication channel from a computer while the gaming device is housed within a dispenser. See discussion supra. Since independent claim 57 is not obvious under Section 103, then any claims depending therefrom are nonobvious, namely claims 62-64. In re Fine. The arguments made above with respect to claims 57-61 regarding the

applicability of Franchi and Gimmon apply with equal force here. See discussion supra. Accordingly, claims 62-64 are patentably distinct as written and the rejection of these claims under Section 103 should accordingly be withdrawn.

Claims 65-79

The Examiner has rejected claims 65-79 under 35 U.S.C. § 103(a) as being unpatentable over Franchi, Gimmon and Walker in view of Rocco (U.S. Patent Application No. 2001/0035425). Regarding claims 65-72, there is no suggestion or motivation to combine Franchi with Gimmon to provide a gaming device capable of receiving data via a secured first two-way communication channel from a computer while the gaming device is housed within a dispenser as discussed above. See discussion supra. Since independent claim 57 is not obvious under Section 103, then any claims depending therefrom are nonobvious, namely claims 65-72. In re Fine. The arguments made above with respect to claims 57-61 regarding the applicability of Franchi and Gimmon apply with equal force here. See discussion supra. Accordingly, claims 65-72 are patentably distinct as written and the rejection of these claims under Section 103 should accordingly be withdrawn.

Regarding claims 73-79, the combination of Franchi and Gimmon fails to provide a gaming device capable of receiving data from a computer while housed in a dispenser as discussed above. See discussion supra.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." MPEP 2143.03.

For the reasons above, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met because the combination of Franchi and Gimmon is improper, namely, there is no suggestion or motivation to combine Franchi with Gimmon to provide "said gaming device able to receive data from said computer while being housed in said dispenser," an express limitation in each of independent claims 73-79. The arguments made above with respect to claims 57-61 regarding the applicability of Franchi and Gimmon apply with equal force here. See discussion supra. Accordingly, the rejection of claims 73-79 under Section 103 should be withdrawn.

III. Conclusion

It is respectfully submitted that the application is now in condition for allowance and, accordingly, reconsideration and allowance are respectfully requested. Should any questions remain regarding the allowability of the application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

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The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of fees which may be required by this paper to Deposit Account No. 502466 including any fee for extension of time, or the fee for additional claims which may be required. Please show our docket number with any Deposit Account transaction. A copy of this letter is enclosed.

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